

REMARKS

The Rejections Under 35 USC § 112

All section 112 rejections are moot in view of the amendments to the claims.

Obviousness-type Double Patenting Rejections

Applicants will attend to this rejection after allowable matter has been identified in the application.

Withdrawn Claims

Regarding withdrawn claims 17, 22 and 24 applicants bring the attention of the Examiner to MPEP § 821.04, Rejoinder, which states that “if the elected invention is directed to the product and the claims directed to the product are subsequently found patentable, process claims [both process of making and using] which either depend from or include all the limitations of the allowable product will be rejoined.” If the restriction requirement is maintained at this point, rejoinder of these non-elected process and method claims is respectfully requested at the proper time in accord with the rejoinder provisions of the MPEP.

Regarding withdrawn claims 23, directed to a kit comprising a compound of elected claim 1, applicants submit that the article of product claim 23 is a combination of the product of the elected claim 1 and another component. As such, the product of the elected claims and the combination of said product and another component are related as combination-subcombination. Since they are related as combination-subcombination, the standard for requiring restriction herein is not met.

In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated. To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary , i.e. separate classification, status, or field of search. See MPEP §808.02. If it can be shown that a combination, as claimed

(1) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and

(2) the subcombination can be shown to have utility either by itself or in other and different relations, the inventions are distinct. When these factors cannot be shown, such inventions are not distinct.

(Emphasis added.) (M.P.E.P. §806.05(c))

It is submitted that the first requirement for two-way distinctness is not established herein. The combination does require the particulars of the subcombination. The product of claim 23 requires the exact same products of the same scope as the subcombination claims of the elected group. To this end, the combination claim is even dependent upon a subcombination-product claim and the subcombination-product is an essential distinguishing feature of the combination-product.

It is respectfully submitted that when the relationship between the claimed subject matter is properly characterized there is no basis for restriction herein.

Thus, the restriction requirement should be withdrawn.

Moreover, the Patent Office has not established that it would pose a serious burden on the Examiner to search all the groups. No further, or only a minimal, search would be necessary to allow the remaining groups once the elected claims are allowed.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,
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